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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,570	03/04/2005	Michael Roreger	512100-2045	8017
7590 Frommer Lawrence & Haug 745 Fifth Avenue New York, NY 10151			EXAMINER ASD/ODL, MOHAMMAD REZA	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 09/03/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/526,570

## Applicant(s)

ROREGER ET AL.

## Examiner

M. REZA ASDJODI

## Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### **Claim Rejections - 35 USC § 102**

*The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:*

**A person shall be entitled to a patent unless –**

**(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

Claims 1, 3-5, 6, 15, 14, 17, 23, 24, 25-27, and 30-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Fox (US 2005/0069575 A1), when taken with Mitchell (US 1,648,778).

Regarding claims 1, 3-5, 6, 15, 30, 25-27, 23, 24, and 31, Fox teaches a water soluble sheet composition comprising: sheet material made of 87-90% hydrolyzed Polyvinyl alcohol; [abstract, 0011, 0013], air pockets (air bubbles); [0048], a soap material such as sodium octanoate, potassium soap, sodium salt of higher fatty acids such as sodium laureth sulfate (alkyl laureth sulfate, LAS, anionic surfactant as foam former); [0005, 0019, 0024, 0026, 0027, 0030, 0033], skin care agents; [0007, 0015], vitamin E; [0037], wherein the composition contains no antimicrobial agents.

Regarding claims 14, and 17, Fox teaches a method of cleaning body in which their sheet composition can be exposed to water for body wash; [0006], in any desired thickness; [0017]. The thickness of leaf soaps are known in the art to be well below 5 mm as evidenced by Mitchell.

With respect to claim 14, and the dissolution time, it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. *In re Swinehart et al.*, 169 USPQ 226 at 229. Since the Fox reference teaches all of the applicant's claimed compositional and process limitations, it is inherent that the

reference article function in the same manner claimed by applicant. The burden is upon applicant to prove that the subject matter shown to be in prior art does not possess the characteristic relied on, [MPEP 2112.01, II]. In the instant case, the dissolution time is a direct result of soap composition and its physical properties such as density and thickness.

### ***Claim Rejections - 35 USC § 103***

*The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:*

***(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.***

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2, 10, 16, 18-20, 22, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox (US 2005/0069575 A1).

Regarding claim 2, 10, 16, and 18-20, as applied to claim 1, Fox teaches the basic soapy sheet of instant claims.

Fox does not teach the elasticity and plasticity, dissolution time, and expandability of their composition. Even though Fox teaches their composition as being

a flexible product; [abstract, 007]. The Office realizes that all the claimed effects or physical properties, such as elasticity/ plasticity, dissolution time, expandability, and single use characteristics are not positively stated by the reference (or: References). However, the reference teaches all of the claimed ingredients in the claimed amount. Therefore, the claimed effects and physical properties (e.g. elasticity/plasticity, ...) would implicitly be achieved by a composition with all the claimed ingredients. If it is the applicant's position that this would not be the case: (1) evidence would need to be presented to support applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties and effects with only the claimed ingredients.

With respect to claim 28, and single use property the mere capability of sheets for being used separately renders the instant claim 28 obvious; [0006, 0009].

Regarding claims 22, and 29, as applied to claim 1, Fox teaches the basic soapy sheet of instant claims.

Fox does not teach the size of air pockets as being in the range of instant claims. Normally, change in bubble sizes, is a routine and expected occurrence, which would be an unpatentable modification. Under some circumstances, however, such changes may impart patentability to a composition if the particular claimed range, or percent, produce a new and unexpected result which is different in kind and not merely in degree from the result of prior art. A prima facie case of obviousness may be rebutted, however, where the results of the optimizing variable, which is known to be result-effective, are unexpectedly good, *In re Boesch and Slaney*, 205 USPQ 215, [MPEP 2441.05]. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to decrease the size of bubbles by increasing the mixing rate or

agitation of mixed soap ingredients (while in liquid form), with the motivation of arriving at smaller bubble size with more uniform distribution though out the soap, which in turn will enhance its solubility and cleaning performance.

Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox (US 2005/0069575 A1), as applied to claim 1, and further in view of Colgate-Palmolive (GB. 1,551,578).

Regarding claims 7-9, Fox teaches the basic composition as set forth for claim 1 above.

Fox does not teach the density of their composition in the range of 0.05-0.7gr/cc. However Colgate-Palmolive teaches a bubble soap composition with the density of 0.5-0.9gr/cc; [pg. 2: L. 5-10]. Colgate-Palmolive and Fox are analogous art because they are from the same field of endeavour, that of bubble soap compositions. At the time of invention, it would have been obvious to a person of ordinary skill in the art to optimize, or adjust, the density of Fox's composition (soap to air pocket ratios) with the motivation of achieving a light weight elastic/plastic soap product, (due to added bubbles), for a better dissolution and more efficient cleaning, as evidenced by Colgate-Palmolive; [pg. 1, 4].

Claims 11-12, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox (US 2005/0069575 A1), as applied to claim 1, and further in view of Schulerud (US 2,525,081), when taken with Mitchell (US 1,648,778).

Regarding claims 11-12, and 21, Fox teaches a method of preparing a soap composition with air pockets (air bubbles); [0048], spreading the soap material on a flat surface (on a PVA sheet) and drying it at room temperature or inside an oven; [0049].

Fox does not teach drying process inside a heating tunnel. However, Schulerud teaches a method of soap preparation wherein the soap material is transported into a drying tunnel and its water is reduced to about 10%; [2: 54-55, 3: 1-4]. At the time of invention, it would have been obvious to a person of ordinary skill in the art to utilize drying method of Schulerud, in fox's method, with the motivation of optimizing the water content of the soap (e.g. 10%) as evidenced by both Schulerud and Fox.

With respect to claim 11, The thickness of leaf soaps are known in the art to be well below 5 mm as evidenced by Mitchell.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fox (US 2005/0069575 A1), as applied to claim 1, and further in view of Mabley (US 2,356,168).

Regarding claim 13, Fox teaches the basic composition as set forth for claim 1 above.

Fox does not, expressly, teach that solid soap preparation is divided into individual doses by means of cutting lengthways, crossways/or punching. However, Mabley teaches a soap preparation method in which sheets of soaps are cut in desired shape and sizes; [pagees 1-2]. Mabley and Fox are analogous art because they are from the same field of endeavour, that of soap compositions. At the time of invention, it would have been obvious to a person of ordinary skill in the art to divide, or cut, the sheets of soaps for individual uses with the motivation of better sanitary consideration for users of this soap sheets as indicated by Mabley.

### ***Response to Arguments***

Applicant's arguments, see pages 8-18, filed 04/27/09, with respect to the rejection(s) of claim(s) 1-29 under 35 U.S.C. 103(a) have been fully considered and are persuasive with respect to combination of Colgate-Palmolive and Sugamoto et al. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Fox.

Claims 30 and 31 are newly added.

This action is non-final.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. M. Reza Asdjodi whose telephone number is (571)270-3295. The examiner can normally be reached on Monday-Friday 8:00-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.



Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Eashoo/  
Supervisory Patent Examiner, Art Unit 1796

/M. R. A./  
Examiner, Art Unit 1796  
08/24/09